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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,943	12/05/2001	Mario Noli	6023-143US (MI/X13874)	7784
570	7590	03/25/2005	EXAMINER	
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103-7013			KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/005,943	<b>Applicant(s)</b> NOLI, MARIO	
	<b>Examiner</b> Paul D Kim	<b>Art Unit</b> 3729	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 15 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is a response to the request for reconsideration filed on 9/2/2004.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Bare et al. (US PAT. 5,665,653).

Bare et al. teach a process of encapsulating an electrochemical sensor comprising steps of: introducing the sensor (603 including an active sensing area 604) and the exposed length of wire (connected with bonding pads as shown in Fig. 5) into a covering element (401) comprising an insulating material (301 as shown in Fig. 3); and covering the sensor and the exposed length of wire by overmolding the sensor and the exposed length of wire with a second insulating material (701) as shown in Fig. 9 (see also col. 4, line 21 to col. 6, line 53).

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bare et al.

Bare et al. teach all of the limitations as set forth above including that the covering element is a covering tube (401 as shown in Fig. 7a) and the covering tube is placed and blocked in a mold (101) for preventing movement of the covering tube. However, Bare et al. do not teach the injection molding for the overmolding. According to Fig. 3, the covering tube is formed by poured or injected as disclosed in col. 4, lines 52-59. Accordingly in Fig. 9, the overmolding process is shown as almost identical process as Fig. 3 and the encapsulating process of Fig. 9 is performed either by pouring or actively drawn into the tool as disclosed in col. 6, lines 48-53. Therefore, although Bare et al. do not disclose the injection molding for encapsulating process, it would have been an obvious to a person of ordinary skill in the art to overmold (encapsulate) the sensor and the wire with the thermoplastic material (col. 5, lines 1-3) of Bare et al. by the injection molding in order to cover the sensor and the wire.

***Allowable Subject Matter***

5. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed 9/2/2004 have been fully considered but they are not persuasive. Applicant argues that the prior art of record fails to disclose the process of overmolding the sensor with thermoplastic material so that the sensor is completely covered with a controlled thickness of insulating material, which must be perfectly sealed on the cable. Examiner traverses the argument. There is no such a limitation that the sensor is completely covered with a controlled thickness of insulating material, which must be perfectly sealed on the cable. There is no such a definition of "overmolding" meaning of "completely covered with a controlled thickness of insulating material, which must be perfectly sealed". Bear teaches the molding process with the insulating material to cover the sensor with the wires (see col. 6, line 65 to col. 7, line 2). Applicant also argues that the prior art of record fails to disclose the thermoplastic material for the covering material. Examiner also traverses the argument. According to the recited limitation in lines 6-8, a covering element comprises a thermoplastic material which is the same as or compatible with the insulating material. Bare discloses the covering element made of an insulating material even though the insulating material is either the thermosetting material or not. Applicant also argues that the prior art of record fails to disclose any overmolding of the sensor with a second thermoplastic material. Examiner also traverses the argument. According to the recited limitation in lines 9-11, the sensor and the wire are covered by overmolding with a second thermoplastic material which is the same as or compatible with the insulating material. Bear teaches that the sensor and the wire are covered with an insulating material even though the

insulating material is either the thermosetting material or not. Applicant also argues that the prior art of record fails to disclose the overmolding process. Examiner also traverses the argument that there is no such a definition of "overmolding" meaning of "completely covered or perfectly sealed". Bear teaches the molding process with the insulating material to cover the sensor with the wires. Examiner assumes that the molding process of Bear is the same molding process of the claimed invention such as the overmolding process.

7. This application contains claims 11-14 and 17 drawn to an invention nonelected with traverse filed on 11/22/2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul D Kim  
Examiner  
Art Unit 3729